

REMARKS

I. Status of Claims

Claims 1-5, 7-13, 15, 16, 18, 19, and 22-25 are pending. Without prejudice or disclaimer, claims 1 and 23 are amended herein to recite “applying to the hair a reducing composition comprising at least one reducing agent before or after applying to the hair the composition comprising at least one ceramide compound, and optionally rinsing the hair.” Support for the amendment can be found, for example, in original claim 14. Without prejudice or disclaimer, claims 15 and 18 are amended to correct dependency, and claims 14, 17, 20, and 21 are cancelled. Claim 6 was previously cancelled, but is now recited in new claims 24 and 25. Thus, no new matter is presented.

II. Rejection under 35 U.S.C. § 103(a)

The Office maintains the rejection of claims 1-23 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,521,219 to Hirata (“Hirata”), in view of U.S. Patent No. 6,076,530 to Braidia-Valerio et al. (“Braidia-Valerio”) and U.S. Patent No. 6,303,110 to Maubru et al. (“Maubru”). Final Office Action at 2-4. Applicants respectfully disagree and traverse this rejection for the reasons of record. However, by this Amendment, Applicants have amended independent claims 1 and 23 to recite “applying to the hair a reducing composition comprising at least one reducing agent before or after applying to the hair the composition comprising at least one ceramide compound, and optionally rinsing the hair,” before raising the temperature of the hair. See *e.g.* claim 1, as-amended. To the extent, however, that the Office may consider rejecting amended claims 1 and 23 based on the rejection of record, Applicants respectfully disagree and

traverse the rejection for the reason that the combination of Hirata, Braida-Valerio, and Maubru would have failed to guide one of ordinary skill in the art to the claims as-amended.

Based on the Supreme Court's decision in *KSR*, the Office has announced seven exemplary rationales that may support a conclusion of obviousness set forth in M.P.E.P. § 2143. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1734 (2007). The Supreme Court's analysis, as well as all of these exemplary bases for obviousness, require that one of ordinary skill in the art, without knowing anything of the claimed invention, would not only have had a suggestion to produce that invention (i.e., modify the teachings of the prior art to arrive at the claimed invention), but also would have had a reasonable expectation of success in arriving at the claimed invention based on the modification of the prior art.

Here, the Office has failed to establish a *prima facie* case of obviousness because it has not shown that, based on the teachings of Hirata, Braida-Valerio, and Maubru, one skilled in the art would have had any reason to modify the process disclosed in Hirata or had any guidance on how to do so in such a manner that the modification(s) would have resulted in the processes of the instant claims.

Specifically, claims 1 and 23 recite, in relevant part, "applying to the hair a reducing composition comprising at least one reducing agent before or after applying to the hair the composition comprising at least one ceramide compound, and optionally rinsing the hair," before raising the temperature of the hair. In contrast, Hirata teaches a three-step method of restoring damaged hair by first hydrating the hair, then applying amino acids and/or peptides to the hair, followed by compressing the hair under heat by sandwiching the hair between heated plates. Hirata at col. 1, ll. 47-57. Although Hirata

suggests that a “styling” step, such as a permanent treatment, may be performed, Hirata only teaches the optional styling step subsequent to the three-step restoring method described above. Hirata at col. 2, line 66 to col. 3, line 2. In other words, Hirata teaches an optional permanent treatment after both applying the nourishing amino acids and/or peptides composition and heat, in contrast to the amended claims, which specify that the ceramide composition and the reducing composition are each applied before heating the hair.

Indeed, Hirata teaches that, when the hair is styled after its restoring method, “the styled hair can last significantly longer than does the conventionally treated hair.” *Id.* at col. 8, ll. 58-61; see *also* Example at col. 10, ll. 27-40 (discussing “better durability” of hair styled following the three-step process described in Hirata compared to hair styled after Hirata’s three-step process without the compression step).

Nothing in Hirata, however, suggests a process wherein both an amide composition and a reducing composition are applied to the hair prior to heating the hair. Consequently, Hirata fails to teach or suggest all of the present claim limitations. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); see *also* M.P.E.P. § 2143.03 (“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Moreover, Hirata fails to teach or suggest a reason for modifying the method disclosed therein, particularly since that method is disclosed to have beneficial results.

Braida-Valerio’s method does not cure the deficiencies in Hirata’s method. In Braida-Valerio’s method, the hair is first treated with a composition containing at least one amide compound with at least one fatty chain, followed by treating the hair with heated steam, and then by cooling. Braida-Valerio at Abstract. Braida-Valerio,

however, fails to even discuss a permanent treatment step or the application of a reducing composition, much less suggest at which point in its method such a step or application would be performed.

Maubru's method also fails to cure the deficiencies in Hirata's method. Rather, Maubru's disclosure actually **conflicts** with the teachings of Hirata. For example, Maubru teaches permanently treating the hair comprising applying to the hair a composition containing at least one ceramide compound and at least one reducing agent. Thus, Maubru teaches applying to the hair a single composition containing at least one ceramide compound and at least one reducing agent, unlike Hirata's express teaching of applying to the hair a nourishing composition followed by heat, and then an optional permanent treatment step.

As discussed above, Hirata's method of repairing damaged hair is a result of the specific three-step method of hydrating the hair, applying the nourishing composition, and then applying heat. Hirata states that this method allows for "the cuticle of the hair shafts [to be] aligned in a direction [such that] the hair shafts can be permed easily and maintain their shape for a long period of time." Hirata at col. 3, ll. 5-7. Therefore, Hirata teaches that the three-step restoring treatment allows, thereafter, for the treated hair to be permanently styled effectively, and thus, would have lead one of ordinary skill in the art away from combining the reducing and nourishing compositions, as in Maubru's invention.

Accordingly, in view of Maubru, one of ordinary skill in the art would have been guided away from modifying Hirata's process in a manner to arrive at the presently claimed processes. It is well known that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its

intended function, then the requisite motivation to make the modification would not have existed. *See, In re Fritch*, 972 F.2d 1260, 1265-66, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (holding the suggested combination of references improper under section 103 because it "would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a change in the basic principles under which [that reference's] construction was designed to operate.").

Accordingly, Applicants respectfully submit that the rejection under § 103 is improper and respectfully request that this rejection be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks , Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 24, 2010

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Reg. No. 63,219